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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,859	03/18/2004	Benjamin Laux	JDI / 291	6538

26875 7590 04/25/2006

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CINCINNATI, OH 45202

EXAMINER
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CARRILLO, BIBI SHARIDAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/803,859	LAUX, BENJAMIN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sharidan Carrillo	1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. In view of the Appeal Brief filed on 2/6/06, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Michael Barr, SPE  
AU1746

A handwritten signature in black ink, appearing to read 'Michael Barr', with a stylized flourish extending from the end.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

Art Unit: 1746

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 3 is nonenabled for the following reasons. Claim 3 recites tripropylene glycol methyl ether. Claim 3 is dependent on claim 1 which recites that the glycol ethers have a vapor pressure or less than 0.1mm Hg at 20 degrees centigrade. Claim 3 is nonenabled because the prior art of Heise teaches that tripropylene glycol methyl ether have a vapor pressure of 0.4 mbar which is equivalent to 0.30 mmHg at a temperature of 20 degrees centigrade. The claim is nonenabled because the prior art teaches that the same identical glycol ether at the same temperature has a vapor pressure which is greater than 0.1mm Hg.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is indefinite for the following reasons. Claim 3 is dependent on claim 1 which recites that the glycol ethers have a vapor pressure or less than 0.1mm Hg at 20 degrees centigrade. The prior art of Heise teaches that tripropylene glycol methyl ether has a vapor pressure of 0.4 mbar which is equivalent to 0.30 mmHg at a temperature of 20 degrees centigrade. The claim is indefinite because it is unclear how applicant's claimed composition of tripropylene glycol ether can have a vapor pressure less than

Art Unit: 1746

0.1 mmHg if the prior art teaches that the same identical glycol ether at the same temperature has a vapor pressure which is greater than 0.1mm Hg (i.e. 0.30 mm Hg).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heise et al. (WO 95/09204).

Heise teaches an organic solvent blend that has a vapor pressure at 20 Degrees centigrade, of at most, 3mbar (i.e. at most 2.25 mm Hg) and consisting of 5-60% by weight of aromatic and optionally aliphatic hydrocarbons, and b) 40-95% by weight of at least one other solvent selected from the group comprising of esters, ethers, ketones, and alcohols. In reference to claim 1, Heise teaches at most 3 mbar

Art Unit: 1746

vapor pressure which is equivalent to at most 2.25 mmHg, which falls within the claimed range of 0.1 mmHg. The teaching of 5-60% aromatic hydrocarbon reads on the petroleum distillate since petroleum, as defined by Hawley's Condensed Chemical Dictionary is a mixture of paraffinic, cycloparaffinic and aromatic hydrocarbons. Additionally, page 2 of the machine translation of Heise teaches that the mixture of aromatic hydrocarbons should have a vapor pressure of less than 4mbar, which is equivalent to less than 3 mmHg.

Heise fails to specifically recite the limitation of 20-50% by weight of glycol ether and at least 10% by weight of a C1-C4 ester having a carbon chain length of less than 18. However, it would have been within the level of the skilled artisan to modify the concentration of the ester and ether since Heise teaches that the total solvent mixture comprising esters and ethers are within a range of 40-95% by weight. Applicant's claim requires a range from 30%-60% mixture of a glycol ether and ester, which falls within the range taught by Heise. In reference to the vapor pressure of the glycol ether, page 3 of the translation teaches diethylene glycol with a vapor pressure of 0.013 mbar which is equivalent to 0.01 mm Hg, at 20 degrees centigrade. In reference to the vapor pressure of the ether, page 3 of the translation teaches that the esters and ethers should have a vapor pressure of at most 1.6 mbar, which is equivalent to a vapor pressure of at most 1.2mmHg. In reference to claim 2, refer to hydrocarbons having boiling points between 150-240 degrees centigrade. In reference to claim 3, page 3 of the translation teaches tripropyleneglycol methyl ether. In reference to claims 4-6, refer to the examples esters, found on page 3 of the translation.

***Response to Arguments***

9. Upon further discussions with SPEs Roy King and Michael Barr on 4/19/2006 and in view of the arguments presented in the Appeal Brief, the rejection of the claims as being unpatentable over Klier is withdrawn in view of a new grounds of rejection, as set forth above.

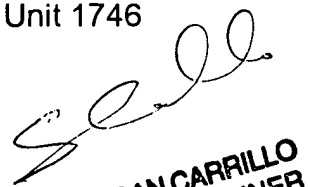
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on M-W 6:30-4:00pm, alternating Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharidan Carrillo  
Primary Examiner  
Art Unit 1746

bsc



**SHARIDAN CARRILLO  
PRIMARY EXAMINER**